



UNITED STATES PATENT AND TRADEMARK OFFICE

JAN 13 2005

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

JONES DAY  
222 EAST 41ST ST  
NEW YORK NY 10017

In re Application of :  
John J. Harrington et al :  
Serial No.: 09/586,744 : PETITION DECISION  
Filed: June 2, 2000 :  
Attorney Docket No.: RI-71904 :

This is in response to the petition under 37 CFR 1.181, filed October 6, 2004, requesting the Office expunge a third protest filed by a third party in the application file.

#### BACKGROUND

A review of the file history shows that this is a Reissue application. After filing the application a third party timely filed a Protest in the application against the issuance of a reissue patent. Applicants replied to the protest. The examiner then issued a first Office action. A second Protest was filed approximately 10 months later raising new issues not previously raised, but which were raised as part of applicants' reply, with applicants also replying to this protest. Subsequently a Final Office action issued. In August, 2003, applicants filed RCE papers and resumed prosecution. A non-Final Office action issued on November 17, 2003. Applicants replied on May 20, 2004. A third protest was filed August 13, 2004. A Final Office action issued on September 1, 2004. This petition was filed October 6, 2004.

#### DISCUSSION

Applicants petition against entry of the third protest citing 37 CFR 1.291(c) relating to limited involvement of third parties in reissue applications. Applicants contend that the three protests have all been filed by the same unnamed third party. Applicants also request that the last two protests be expunged from the record in that they respond to applicants' reply to the outstanding Office actions and do not truly raise or respond to any new issues.

As a matter of policy all protests in an application, including a reissue application, are reviewed for content, appropriateness and timeliness by management staff prior to entry into an application file. The decision to enter or not enter a protest rests on multiple factors. Paramount among those factors is whether the issues raised are (a) new (and could not have been raised before, possibly due to arguments made in applicants' reply) and (b) have an impact on any decision relating to patentability of the claims. This is especially so in second and subsequent protests in the same application. In each instance the filed protest was reviewed by management personnel

and a decision made that the merits of the protest were important in deciding issues of patentability. Note that the facsimile cover sheet accompanying the last protest contains a signature of approval for entry. It is also noted that issues raised in the last protest form the basis of at least part of the Office action mailed September 1, 2004, thus indicating its value in the determination of patentability.

#### DECISION

The petition is **DENIED**.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

A handwritten signature in black ink, appearing to read "B. M. Kisliuk", with a stylized flourish at the end.

Bruce M. Kisliuk  
Director, Technology Center 1600